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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/220,617	12/24/1998	EUGENE M. JOHNSON	6029-7976	3176

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EXAMINER

HAYES, ROBERT CLINTON

ART UNIT PAPER NUMBER

1647

DATE MAILED: 08/12/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/220,617

Applicant(s)  
Johnson et al

Examiner  
Robert C. Hayes, Ph.D.

Art Unit  
1647

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Jun 29, 2001
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 10-15, 26, and 28-40 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claims 10-15, 26, and 28-40 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

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## **DETAILED ACTION**

### ***Election/Restriction***

1. Applicant's election with traverse of Group I (claims 10-15, 28-30, & 34-40) in Paper No. 7 is acknowledged. The traversal is on the ground(s) that "claim 26 has been amended to eliminate the limitation that the claimed persephin polynucleotide has the purpose of preventing transcription", that "[w]ithout this limitation, the claim is essentially identical to claim 11", and that "the claims of Group I cannot be distinguished structurally from the claims of Group II". This is not found persuasive because molecules that hybridize to the coding strand of a polynucleotide are not "structurally identical" as illustrated by the separate SEQ ID NOs given to the complementary strands of the persephin-encoding polynucleotides, which further have different uses than that elected in Group I. Note that "probes" in Group II would be alternatively classified in Class/subclass: 536/24.3, versus 536/23.5 for the polynucleotides of Group I that also require host cells and vectors (Class/subclass 435/325), not required in Group II. Therefore, because different considerations and search parameters are used in a complete search of these structurally distinct nucleic acid molecules, and because of the non-coextensiveness of the search and examination for each group would constitute an undue burden on the examiner to search and consider each of these separable groups, the previous restriction was proper. However, because of the additional distinct SEQ ID NOs recited in Group I that are now defined in compliance with the SEQUENCE RULES, the following additional restriction requirement of elected Group I is now necessitated.

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2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- IA. Claims 10-15, 30 & 37-40, drawn to polynucleotides encoding murine pre-pro-persephin polypeptides, vectors, and associated host cells (i.e., murine SEQ ID NOs 179, 180, 181, 182, 183 & 184), classified in Class 435, subclass 325.
- IB. Claims 10-15, 30 & 37-40, drawn to polynucleotides encoding rat pre-pro-persephin polypeptides, vectors, and associated host cells (i.e., rat SEQ ID NOs SEQ ID NOs: 190, 191, 192, 193, 194 & 195), classified in Class 435, subclass 325.
- IC. Claims 10-15, 28-30 & 34-40, drawn to polynucleotides encoding human pre-pro-persephin polypeptides, vectors, and associated host cells (i.e., human SEQ ID NOs: 199-202, 203-206, 213-216, 207-210, 211-212, 221 & 223), classified in Class 435, subclass 325.

3. The inventions are distinct, each from the other because of the following reasons:

Although there are no provisions under the section for "Relation of Inventions" in MPEP 806.05 for inventive groups that are directed to different products, restriction is deemed proper because these products appear to constitute patently distinct inventions for the following reason:

Groups IA-IC are directed to products that are physically and functionally distinct, as illustrated by their distinct and unique SEQ ID Nos, and the separate and distinct mammalian

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species from where each is isolated. It is pointed out that there is a proper distinction between these groups, since each product is not required in order for the other to exist. Thereby, these groups are distinct and separable for the reasons stated.

Because these inventions are distinct for the reasons given above, they have acquired a separate status in the art as shown by their different classification, and the non-coextensiveness of the search and examination for each group would constitute an undue burden on the examiner to search and consider each of the separable groups with their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

4. Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed. Additionally, in order to be fully responsive to this restriction requirement the claims will need to be amended to separate murine, rat and human claims.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(I).

Laslty, note that human SEQ ID NOs: 203 and 205, 204 and 206, 213 and 215, 214 and 216, 207 and 209, 208 and 210, 199 and 201, 200 and 202, respectively, are identical sequences,


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and therefore, duplicative. Recitations of SEQ ID NOs: 180, 182, 184, 191, 193, 195, 200, 202, 204, 206, 208, 210, 212, 214 and 216 also appear to merely be the complementary strands for the murine, rat and human persephin-encoding polynucleotides, and therefore, are redundant and only confuses the record (and specification). Thus, amendment of the claims to remove duplicate claim language is further strongly suggested.

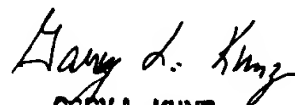
5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Robert Hayes whose telephone number is (703) 305-3132. The examiner can normally be reached on Monday through Thursday, and alternate Fridays, from 8:30 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz, can be reached on (703) 305-4623. The fax phone number for this Group is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.



Robert C. Hayes, Ph.D.  
August 7, 2002

  
GARY L. KUNZ  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1500